UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,526	01/14/2000	Anthony M. Pilaro	12086	8505

7590 09/30/2003

Joseph A. Mahoney
Mayer, Brown, Rowe & Maw
P.O. BOx 2828
Chicago, IL 60690-2828

EXAMINER	
WILSON, JOHN J	

ART UNIT	PAPER NUMBER
3732	22

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/483,526	Applicant(s) PILARO ET AL.	
	Examiner John J. Wilson	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 June 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,8,19-31 and 40-83* is/are pending in the application.

4a) Of the above claim(s) *30,31 and 50-58* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,8,19-31 and 40-83* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Applicant's election without traverse of Group I, claims 1-5, 7, 8, 19-29 and 40-49 in Paper No. 10 is acknowledged. Claims 30, 31 and 50-58 stand withdrawn as being directed to non-elected inventions. Newly submitted claims 59-83 are grouped with the elected invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4, 5, 19, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murljacic (US 5766006) in view of Roggenkamp (US 4448307) and Knudson (3936936). Murljacic shows a method for providing tooth whitening, however, does not show simultaneously administering to more then one patient. Roggenkamp teaches that it is known that dentist simultaneously provide treatment to more than one patient, column 1, lines 21-28. It would be obvious to one of ordinary skill in the art to modify Murljacic to include simultaneously providing treatment to more than one patient as shown by Roggenkamp in order to more efficiently provide patient treatment. The above combination teaches using different rooms, however, does not specifically teach workstations. Knudson shows different workstations. It would be further obvious to one of ordinary skill in the art to modify the above combination to include workstations as

shown by Knudson in order to better service the patient. The above combination teaches working on the patients practically simultaneously, however, does not specifically teach simultaneously. Knudson teaches that it is known to work on another patient during a wait time of a method being preformed on the first patient, column 1, lines 12-15, as is well known in the art, for example the well known method of filling a cavity that includes the step of administering anesthetic and waiting to the anesthetic to take hold. It would be further obvious to modify the above combination to include simultaneously working on more than one patient as shown by Knudson. As to claim 2, see column 1, lines 10-19 of Murljacic. As to claims 23-25, the productivity coefficient depends on the times required to whiten teeth which are known in the art to depend on the process and whitener used and on the interpretation of the patient and/or doctor as to how much whitening is desired, therefore, the specific time required is an obvious matter of choice to the skilled artisan. As to claim 26, the use of an examination chair in dental application is well known.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murljacic (US 5766006) in view of Roggenkamp (US 4448307) and Knudson (3936936) as applied to claim 2 above, and further in view of Migurski et al (US 5964065). The above combination does not show evaluating at a location physically removed from the workstations. Migurski teaches evaluating patients at removed locations, column 5, lines 45-54. It would be further obvious to one of ordinary skill in the art to modify the

above combination to include evaluating at a removed location as shown by Migurski in order to more efficiently service patients.

Claims 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murljacic in view of Roggenkamp and Knudson as applied to claim 1 above, and further in view of Kutsch (6149895). The above combination does not show priming the teeth. Kutsch teaches priming the teeth, column 11, lines 43 and 44. It would be obvious to one of ordinary skill in the art to modify the above combination to include priming the teeth as shown by Kutsch in order to prepare the teeth for whitening.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murljacic (US 5766006) in view of Roggenkamp (US 4448307) and Knudson (3936936) as applied to claim 1 above, and further in view of Cornell 5032178). The above combination does not show a specific time period. Cornell shows a time period of 5-15 minutes, column 3, line 44. It would be obvious to one of ordinary skill in the art to modify The above combination to include a time period as shown by Cornell in order to treat the teeth within known time periods. The specific time period used is an obvious matter of choice in the degree of a known parameter to the skilled artisan.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murljacic in view of Roggenkamp and Knudson and Kutsch as applied to claim 8 above, and further in view of Prencipe et al (5698182). The above combination does not show the

use of flavoring. Prencipe teaches using flavoring in a dentifrice, column 4, lines 29-37. It would be obvious to one of ordinary skill in the art to modify the above combination to include flavoring as shown by Prencipe in order to make the composition more pleasant for the patient.

Claims 40-43, 45, 46, 69-75, 82 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854) and Kutsch (6149895). Cornell teaches applying a whitening gel to teeth and applying light, column 1, lines 17-39. Cornell does not show applying the gel to all cosmetically visible teeth and does not show applying light to all said teeth simultaneously. Nikodem teaches simultaneously applying light to a plurality of teeth to reduce the time of the procedure, column 1, lines 60-67, and further teaches that the method can be used for whitening teeth, column 1, lines 54-58. It would be obvious to one of ordinary skill in the art to modify Cornell to include simultaneously whitening teeth as taught by Nikodem in order to reduce the time required. The above combination does not show repeating the method steps. Kutsch teaches repeating method steps three or five times for whitening teeth, column 15, lines 46-53. It would be obvious to one of ordinary skill in the art to modify the above combination to include repeating the method steps in order to achieve the desired results. The specific compositions used are obvious matters of choice in the use of known tooth whitening compositions to the skilled artisan.

Claims 44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854) and Kutsch (6149895) as applied to claim 40 above, and further in view of Yarborough (5713738). The above combination does not show isolating the gingival tissue. Yarborough teaches isolating gingival tissue, column 2, lines 40-54. It would be obvious to one of ordinary skill in the art to modify the above combination to include isolating gingival tissue as shown by Yarborough in order to protect the gums.

Claims 48 and 59-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854) and Kutsch (6149895) as applied to claim 40 above, and further in view of Kutsch (6149895) and Pellico (5928628). The above combination does not show using the claimed percentage of hydrogen peroxide. Kutsch teaches the use of hydrogen peroxide. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of hydrogen peroxide as shown by Kutsch in order to make use of well known compounds for whitening teeth. The above combination does not show using the claimed range of hydrogen peroxide. Pellico shows using 7% - 30%, preferably 11%-22% hydrogen peroxide, column 4, lines 1-8. It would be obvious to one of ordinary skill in the art to modify the above combination to include the percentages as shown by Pellico in order to make use of art known percentages for whitening teeth. The specific range used is an obvious matter of choice in the degree of a known parameter to the skilled artisan.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854) and Kutsch (6149895) as applied to claim 40 above, and further in view of Murljacic (5766006). The above combination does not show using a shade guide. Murljacic teaches using shade guide to compare color, column 1, lines 31-46. It would be obvious to one of ordinary skill in the art to modify the above combination to include using shade guides as shown by Murljacic in order to determine the whiteness of the teeth.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854) and Kutsch (6149895) as applied to claim 40 above, and further in view of Prencipe et al (US 5698182). The above combination does not show the use of flavoring. Prencipe teaches using flavoring in a dentifrice, column 4, lines 29-37. It would be obvious to one of ordinary skill in the art to modify the above combination to include flavoring as shown by Prencipe in order to make the composition more pleasant for the patient.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854), Kutsch (6149895) and Yarborough (5713738) as applied to claim 47 above, and further in view of Prencipe et al (US 5698182). Pellico teaches using flavoring in a whitening gel, column 4, lines 47-51. It would be obvious to one of ordinary skill in the art to modify the above combination to include a flavoring agent in order to render the composition more appealing to the patient. As to

claim 28, Pellico teaches adding flavoring to oral compositions. To add flavoring to an isolating material would be obvious to the skilled artisan in order to render the oral composition more appealing to the patient.

Claims 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854) and Kutsch (6149895) as applied to claim 40 above, and further in view of Tarver (6030222). The above combination does not show using a desensitizing agent. Tarver teaches using a desensitizing agent, column 1, lines 50-62. It would be obvious to one of ordinary skill in the art to modify the above combination to include a desensitizing agent as shown by Tarver in order to improve the patient's comfort. The specific agent used is an obvious matter of choice in the use of known agents to one of ordinary skill in the art.

Claims 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854), Kutsch (6149895) and Knudson (3936936). Cornell teaches applying a whitening gel to teeth and applying light, column 1, lines 17-39. Cornell does not show applying the gel to all cosmetically visible teeth and does not show applying light to all said teeth simultaneously. Nikodem teaches simultaneously applying light to a plurality of teeth to reduce the time of the procedure, column 1, lines 60-67, and further teaches that the method can be used for whitening teeth, column 1, lines 54-58. It would be obvious to one of ordinary skill in the art to modify Cornell to include simultaneously whitening teeth as taught by Nikodem in order

to reduce the time required. The above combination does not show repeating the method steps. Kutsch teaches repeating method steps three or five times for whitening teeth, column 15, lines 46-53. It would be obvious to one of ordinary skill in the art to modify the above combination to include repeating the method steps in order to achieve the desired results. The above combination does not show using workstations to treat more than one patient. Knudson teaches workstations 37. It would be obvious to one of ordinary skill in the art to modify the above combination to include workstations as shown by Knudson to more efficiently treat patients.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 40, 42, 44 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Montgomery et al (6162055).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

Claims 41, 43, 48 and 59-83 are rejected under 35 U.S.C. 103(a) as being obvious over Montgomery et al (6162055), Montgomery et al (6343933) or Cipolla (6416319).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the

reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). The number of times the teeth are whitened is an obvious matter of choice in the duplication of known steps to one of ordinary skill in the art. The length of time the teeth are whitened is an obvious matter of choice to the skilled artisan in the degree of a known parameter to determine the final whiteness of the teeth. The specific range of the component hydrogen peroxide used is an obvious matter of choice the degree of a parameter that will vary the whitening procedure in ways known to the skilled artisan.

Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al (6162055), Montgomery et al (6343933) or Cipolla (6416319) as applied to claim 40 above, and further in view of Kutsch (6149895). The above references do not show priming the teeth. Kutsch teaches priming the teeth, column 11, lines 43 and 44. It would be obvious to one of ordinary skill in the art to modify the above references to include priming the teeth as shown by Kutsch in order to prepare the teeth for whitening.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al (6162055), Montgomery et al (6343933) or Cipolla (6416319) as applied to claim 40 above, and further in view of Murljacic (5766006). The above references do not show using a shade guide. Murljacic teaches using shade guide to

compare color, column 1, lines 31-46. It would be obvious to one of ordinary skill in the art to modify the above references to include using shade guides as shown by Murljacic in order to determine the whiteness of the teeth.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 40-48 and 59-83 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6416319 in view of Kutsch (6149895). The claims of the '319 patent teach whitening teeth simultaneously, however, do not show priming the teeth nor using a gel. Kutsch teaches priming the teeth, column 11, lines 43 and 44, and teaches using a gel. It would be obvious to one of ordinary skill in the art to modify the the claims of the '319 patent to include priming the teeth and to use a gel as shown by Kutsch in order to prepare the teeth for whitening and in order to make use of known ways in the art of

applying whitening material to the teeth. The number of times the teeth are whitened is an obvious matter of choice in the duplication of known steps to one of ordinary skill in the art. The length of time the teeth are whitened is an obvious matter of choice to the skilled artisan in the degree of a known parameter to determine the final whiteness of the teeth. The specific range of the component hydrogen peroxide used is an obvious matter of choice the degree of a parameter that will vary the whitening procedure in ways known to the skilled artisan.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over claims 1-21 of U.S. Patent No. 6416319 as applied to claim 40 above, and further in view of Murljacic (5766006). The above references do not show using a shade guide. Murljacic teaches using shade guide to compare color, column 1, lines 31-46. It would be obvious to one of ordinary skill in the art to modify the '319 claims to include using shade guides as shown by Murljacic in order to determine the whiteness of the teeth.

Priority

Applicant's claim for domestic priority, which it is assumed was made under 35 U.S.C. 120 is acknowledged. However, application 09/651,170 was filed August 30, 2000 while the present application was filed January 14, 2000. Priority cannot be claimed for an application that was filed after the application that is attempting to claim the priority. Therefore, the priority to the 09/234,038 application, which is linked by the

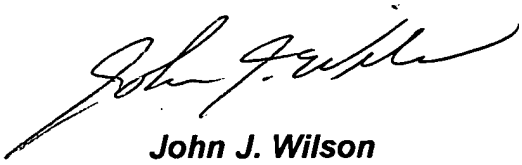
'170 application is also not granted. Applicant must correct or delete the claim from the specification.

Response to Arguments

Applicant's arguments filed June 25, 2003 have been fully considered but they are not persuasive. Applicant's method is directed to simultaneously treating more than one patient in a procedure including method steps. In applicant's application, the treating doctor is not able to be in two places at the same time. Similarly, the applied rejection above treats more than one patient at a time within the bonds of the method steps being applied to the patients. The above combinations solve the problems, and therefore are analogous art even if they come from a different field of art. Nikodem does suggest use with tooth whitening, and therefore, is a proper combination.
Any language added to the claims that finds support only in incorporation by reference must be specifically pointed out. Such language, if essential material, must be supported in the reference and the reference must not also incorporate by reference. The language if not essential is merely state of the art.

Conclusion

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
September 23, 2003
Fax (703) 308-2708
Work Schedule: Monday through Friday, Flex Time